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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,359	09/04/2003	Jerry D. Coombs	31118-US-03	7837
5179	7590	09/18/2007	EXAMINER	
PEACOCK MYERS, P.C. 201 THIRD STREET, N.W. SUITE 1340 ALBUQUERQUE, NM 87102			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3637	
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			09/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,359	Applicant(s) COOMBS ET AL.	
	Examiner M. Safavi	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, line 4, "the short axis" lacks antecedent basis within the claim. It is therefore, not clear as to what the "short axis" refers. Further, it is not understood how an axis can be "short" particularly, since axes do not possess any specific length.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller

'794. Miller '794 discloses, Fig. Figs. 1 and 2 and at col. 4, lines 15-19, an insulated

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concrete form comprising first and second substantially opposing panels P_1 P_2 , each panel having a top surface, bottom surface, first end surface, second end surface, an exterior surface defining a wall and an interior surface for receiving concrete; and at least two ties G for interconnecting the first and second substantially opposing panels, each tie having a plurality of horizontal wires 22 and a plurality of vertical wires (24, 26 when oriented vertically as is disclosed at col. 4, lines 15-19), wherein each horizontal wire in a tie touches and is fixed to each vertical wire in the tie, col. 3, line 47. Metal strips 32 are fixedly attached to the horizontal wires 22 adjacent the opposite ends thereof. The language of claim 10 appears directed to an insulating concrete form per se with no specific relationship to the earth being set forth. As such, language to "said panels disposed such that the short axis of the panels are vertical" appears directed to intended use or intended orientation which would not serve to further limit the language of claim 10 over what is disclosed by Miller '794. With respect to "the short axis", as best understood, the "short axis" of Miller '794 can run along any extent of the side of the panel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller '794. Miller '794 discloses, Fig. Figs. 1 and 2 and at col. 4, lines 15-19, an insulated concrete form comprising first and second substantially opposing panels P_1 P_2 , each panel having a top surface, bottom surface, first end surface, second end surface, an exterior surface defining a wall and an interior surface for receiving concrete; and at least two ties G for interconnecting the first and second substantially opposing panels, each tie having a plurality of horizontal wires 22 and a plurality of vertical wires (24, 26 when oriented vertically as is disclosed at col. 4, lines 15-19), wherein each horizontal wire in a tie touches and is fixed to each vertical wire in the tie, col. 3, line 47. Metal strips 32 are fixedly attached to the horizontal wires 22 adjacent the opposite ends thereof. The language of claim 10 appears directed to an insulating concrete form per se with no specific relationship to the earth being set forth. As such, language to "said panels disposed such that the short axis of the panels are vertical" appears directed to intended use or intended orientation which would not serve to further limit the language of claim 10 over what is disclosed by Miller '794. Otherwise, and with respect to "the short axis", to have formed the Miller form panel of a square configuration would have constituted an obvious expedient to one having ordinary skill in the art particularly since it has been established that mere change in shape has no patentable significance unless a new and unexpected result is produced. See, *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Thus, with a square shaped panel the "short axis" can run along any extent of the side of the panel.

Claims 1-6, 8, and 9 are allowed.

Claims 11-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claim 10 have been considered but are moot in view of the new ground(s) of rejection. At any rate, and as presented above, the language of claim 10 appears directed to an insulating concrete form per se with no specific relationship to the earth being set forth. As such, language to "said panels disposed such that the short axis of the panels are vertical" appears directed to intended use or intended orientation which would not serve to further limit the language of claim 10 over the applied prior art. Further, elements 32 of Miller '794 constitute metal strips.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

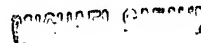
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



M. Safavi
September 10, 2007